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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,512	07/06/2001	Richard Norris Dodge II	11710-0112	3910

7590 01/29/2003

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EXAMINER	
PIERCE, JEREMY R	
ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-6

Office Action Summary	Applicati n No.	Applicant(s)	
	09/900,512	DODGE ET AL.	
	Examiner	Art Unit	
	Jeremy R. Pierce	1771	

-- Th MAILING DATE of this communication appears on th cov r sh et with the correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 July 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 1-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-47 are indefinite because claims merely setting forth physical characteristics desired in an article and not setting forth specific compositions, which would meet such characteristics are invalid as vague and indefinite because they cover any conceivable combination of ingredients, either presently existing or which might be discovered in the future. Claims 1-47 would impart desired characteristics too broad and indefinite since it purports to cover everything which will perform the desired functions regardless of its composition and, in effect, recites compounds by what it is desired that they do rather than what they are. *Ex parte Slob* (PO BdApp) 157 USPQ 172.

Claim Rejections - 35 USC § 102/103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-47 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Goldman et al. (U.S. Patent No. 5,669,894).

Mukaida et al. teach an absorbent product comprising fiber and superabsorbent (Abstract). The superabsorbent makes up 25 to 75% of the total weight. Although Mukaida et al. do not explicitly teach the limitations of composite permeability and intake rate giving values that fit Applicant's equation, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. superabsorbent and fibers) and in the similar production steps (i.e. air-forming) used to produce the absorbent composite. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. Since Applicant has not set forth any significant structure in the claims, the Examiner must assume that a reference that meets the limitations that are present (fibers and superabsorbent) would inherently meet the desired properties. The Examiner has no reasonable way to search for Applicant's claimed property, and cannot conduct tests on the material provided in prior art references to see if they meet the equations provided by the Applicant. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. With

regard to claims 18-21, Mukaida et al. disclose the weight to be 400 grams per square meter (column 9, line 2). With regard to claim 22, Mukaida et al. disclose the superabsorbent polymer can be sodium polyacrylate (column 9, line 57). With regard to claim 41, Mukaida et al. disclose using an air-forming step (column 9, line 1).

5. Claims 1-47 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Goldman et al. (U.S. Patent No. 5,669,894).

Goldman et al. disclose an absorbent member containing superabsorbent polymers and fibers (column 27, line 34 –column 28, line 13). Although Goldman et al. do not explicitly teach the limitations of composite permeability and intake rate giving values that fit Applicant's equation, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. superabsorbent and fibers) and in the similar production steps (i.e. air-forming) used to produce the absorbent composite. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. Since Applicant has not set forth any significant structure in the claims, the Examiner must assume that a reference that meets the limitations that are present (fibers and superabsorbent) would inherently meet the desired properties. The Examiner has no reasonable way to search for Applicant's claimed property, and cannot conduct tests on the material provided in prior art references to see if they meet the equations provided by the Applicant. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. With regard to

claims 18-21, Goldman et al. disclose the basis weight can be 10 to 1000 grams per square meter (column 28, lines 24-32). With regard to claim 22, sodium polyacrylate is used as the superabsorbent (column 17, line 68). With regard to claim 41, Goldman et al. use air-forming steps in making the acquisition layer of the composite (column 34, lines 7-8).

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-47 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23, 31, and 32 of copending Application No. 09/475,830. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same structural limitations are present in the claims and similar property claims are present. The additional limitation of composite permeability and intake rate meeting certain equations in the present application would be inherent or obvious to provide over the claims of the 09/475,830 application, for the same reasons set forth in the prior art rejections.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (703) 605-4243. The examiner can normally be reached on Monday-Thursday 7-4:30 and alternate Fridays 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Jeremy R. Pierce
Examiner
Art Unit 1771

ELIZABETH M. COLE
PRIMARY EXAMINER

January 23, 2003